

REMARKS/ARGUMENTS

I. Status of the Claims

Prior to entry of this amendment, claims 1-19 are pending. An office action mailed June 7, 2006 rejected claims 1-19 under the second paragraph of 35 U.S.C. § 112. The office action also rejected claims 1-11, 14 and 16-19 under 35 U.S.C. § 102(e) as being anticipated by Porcari (US2001/0037460), rejected claims 12 and 13 under 35 U.S.C. § 103(a) as being unpatentable over Porcari, and rejected claim 15 under § 103(a) as being unpatentable over the combination of Porcari and Rivette (US 2003/0046307). This amendment amends claims 1, 2, 6-12 and 14-19, cancels claim 13 without prejudice or disclaimer, and adds new claims 20-22. Hence, after entry of this amendment, claims 1-12 and 14-22 stand pending for examination.

II. Interview Summary

The applicants appreciate the courtesy and professionalism shown by the Examiner during the telephonic interview held between the Examiner and the undersigned on October 24, 2006. During that interview, the undersigned explained why the Porcari reference does not teach or suggest the elements of any pending claim. The Examiner stated that the claims did not clearly point out the features of the invention believed to be novel over the cited reference. Hence, no agreement was reached with respect to the claims.

III. Claim Amendments

Claim 1 has been amended to replace the term "first electronic documents" with the term "reference documents" for additional clarity. Additionally, the term "second electronic document" has been replaced with the term "citation document" for similar reasons. It is submitted that these amendments do not narrow the scope of claim 1, since claim 1 previously recited that the "first electronic documents" comprise reference information and that the "second electronic document" comprises citation information.

Claim 1 has also been amended to recite "providing communication between the server system and a client system, wherein the client system is configured to provide interaction

between a user and the server system.” It is submitted that this element finds support throughout the specification, including in particular in Figs. 1, 10 and 11, and the corresponding portions of the written description, such as, for example, lines 1-31 on page 23 of the application.

Claim 1 has been further amended to recite “providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.” This element replaces the former recitation, “wherein the user enters information into the server system using the input select elements, the information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers,” and it is believed that the new element is supported in large part by the former recitation. Further support for this element can be found throughout the specification, including inter alia, Figs. 20 and 21, and the corresponding portions of the written description (including, in particular, lines 30-25 on page 35 and lines 1-6 and 18-28 one page 36 of the application).

In addition, claim 1 has been amended to recite “a first reference” and a single “identifier” and “interface element” to reduce the confusion created by the former recitation of “a plurality of identifiers” and “plurality of input select elements.” It should be understood, however, that these amendments are not intended to narrow the scope of claim 1, and, in fact, new claim 20 specifically recites the display of a plurality of identifiers and the provision of a plurality of interface elements.

Claim 1 also contains further stylistic amendments to provide further clarity. It is submitted that these stylistic amendments do not narrow the scope of claim 1.

Claims 2, 6-12 and 14-19 have been amended for consistency with the amendments to claim 1.

This amendment also introduces three new claims: claims 20-22. As noted above, claim 20 recites “displaying, in the second display section, a plurality of identifiers, each of the plurality of identifiers corresponding to one of the references stored on the server system” and “providing a plurality of interface elements, each of the plurality of interface elements being

associated with one of the plurality of identifiers.” It is submitted that claim 20 is supported by prior claim 1 and the portions of the specification supporting that claim.

New claim 21 recites a system that corresponds generally to claim 1, and claim 21 therefore finds support in claim 1 and the portions of the specification supporting that claim, as well as various portions of the specification, including in particular lines 22-31 on page 7 and lines 3-6 on page 8 of the application. Similarly, claim 22 is directed to a computer program embodied on at least one computer readable memory, and it recites elements similar to some of those found in claim 1. Claim 22, therefore, also finds support in claim 1 and the portions of the specification supporting that claim, as well as various portions of the specification, including in particular lines 22-31 on page 7 and lines 3-6 on page 8 of the application.

IV. Claim Rejections under 35 U.S.C. § 112

The office action rejected all pending claims under § 112, ¶2 as being indefinite because the Office found the following language in claim 1 to be unclear: “wherein the user enters information into the server system using the input select elements, the information corresponding to the relation between the displayed citation information and the displayed plurality of identifiers.” This language has been removed from claim 1, and it is believed that the new language more clearly defines the scope of the claimed invention. Reconsideration of the rejections under § 112, therefore, is respectfully requested.

V. Claim Rejections under 35 U.S.C. §§ 102 and 103

Claims 1-11, 14 and 16-19 were rejected under § 102 as being anticipated by Porcari. It is respectfully submitted, however, that Porcari fails to teach or suggest the elements of even independent claim 1, and that the rejected claims, therefore, are allowable over Porcari.

In rejecting claim 1, the office action relied entirely on paragraphs 0056-0058 of Porcari. Those paragraphs are reprinted in full below:

[0056] The system optionally includes a system to reference prior art documents and a method hyperlinks to the stored reference. The

USPTO requires disclosure of relevant references and current rules require that paper copies of these references be provided with the patent application. The applicant must later forward these paper copies. The present invention anticipates a method of Information Disclosure Statement in XML form that contains hyperlinks to identified documents in the USPTO Patent Full Text and Image Database or the European Patent Office (EPO) Esp@ce and the EPO maintain databases using Uniform Resource Locator (URL)-based systems where U.S. Pat. No. 5,579,858 may currently be viewed through the hyperlink: "http://164.195.100.Sect1=PTO1&Sect2=HITOFF&d=PALL&p=1&u=/netah-tml/srchnum.htm&r=1&f=G&I=50&s1

[0057] In those instances where there is no internet accessible archive, the present invention contemplates commercial prior art services that will host the document for permanent record storage. Access to the public and patent offices would be through a web interface or URL link as described. One example of a commercial internet-based prior art archive is IP.COM whose web page is www.ip.com. Linking the prior art eliminates the need to submit paper copies. Only one copy of the reference is needed for use with many applications.

[0058] The docketing system records the prior art reference either through a citation system such as patent number (country, number, kind) or through a uniform citation system as are commonly used in technical journals. The docketing system prepares an information disclosure statement where the citation system links to a repository on the internet that contains the referenced document. The information disclosure system is preferably transmitted as an XML file having hyperlinks to each reference.

This disclosure, however, clearly fails to teach or suggest each element of claim 1. For example, claim 1 recites, inter alia, displaying citation information in a first display section and displaying, in a second display section an identifier corresponding to a first reference. Porcari fails to teach or suggest this use of multiple display sections. Further, claim 1 recites,

inter alia, “providing an interface element associated with the identifier, wherein the interface element is configured to receive, from the user, input pertaining to the first reference, the input comprising information about a relationship between at least some of the citation information in the citation document and the first reference.” Porcari similarly fails to teach or suggest this element.

Indeed, the brief teaching in Porcari that is relevant to the present claims merely suggests that a system to disclose relevant references might prepare an information disclosure statement “where the citation system links to a repository in the internet that contains the referenced document.” (Porcari, ¶ 0058). In contrast, claim 1 is directed to a method in which a citation document (such as a notice of cited references, etc.) is received, and in which citation information from that document is displayed alongside an identifier for a reference, along with an interface element that is configured to receive input comprising information about a relationship between (at least some of) the citation information and the reference. This functionality could, for example, be used to allow a user to indicate whether a particular reference has been considered by the patent office, (see, e.g., claim 12) which beneficially can be used to ensure that all relevant references have been considered.

Accordingly, it is respectfully submitted that Porcari fails to teach or suggest each element of even claim 1, and that claim 1, therefore is allowable over Porcari. Independent claims 21 and 22 are believed to be allowable for at least similar reasons. Dependent claims 2-11, 14 and 16-19 are believed to be allowable at least by virtue of their dependence from claim 1.

VI. Claim Rejections under 35 U.S.C. §103

The office action also rejected claims 12, 13 and 15 under § 103(a) as being unpatentable over Porcari, taken either alone or in combination with Rivette. Claim 13 has been canceled, but claims 12 and 15 each depend from claim 1, which, as noted above, is allowable over Porcari. Since Rivette does not remedy the disclosure missing from Porcari, claims 12 and 15 are believed to be allowable at least by virtue of their dependence from claim 1.

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Amdt. dated November 7, 2006
Reply to Office Action of June 7, 2006


PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,


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Attachments
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